

REMARKS

In a previous Office Action, the Examiner required restriction of the present patent application to Invention I (claims 1-18 directed to a landscape edging system) or Invention II (directed to a method of manufacturing a landscape edging system). The Applicant elected to restrict the present application to Invention I without traverse to the restriction requirement. In the present Office Action, the Examiner objected to claims 7, 8, 16 and 17 due to informalities in the language of those claims and rejected claims 1-18, all claims currently pending in the subject patent application, under 35 U.S.C. § 103(a) as being unpatentable in light of various combinations of prior art patents. In response, the Applicant hereby cancels claims 19 and 20, amends claims 7, 8, 16 and 17 to correct the informalities and submits arguments in opposition to the Examiner's rejection of claims 1-18 due to obviousness and in support of the patentability of those claims. As set forth in more detail below, the Applicants believe the arguments and amendments made in response to the Examiner's rejections have placed the application in condition for allowance.

Restriction - Claims 19 and 20

These claims are being cancelled in light of the Applicant's previous election to restrict the present application to the landscape edging system of Invention I, claims 1-18.

Informalities - Claims 7, 8, 16 and 17

The Examiner objected to claims 7, 8, 16 and 17 due to the Applicant's use of "extending portion" in those claims. The Examiner required correction of these claims to replace the foregoing with "one or more extending portions) to comport with the language of the respective independent claims from which they depend (i.e., claims 1 and 12). As set forth herein, the Applicant has amended claims 7, 8, 16 and 17 to comply with the Examiner's request. It is believed that these amendments will remove the Examiner's objection.

1 Obviousness (35 U.S.C. § 103(a))

2 With regard to the obviousness rejections for Applicant's patent application, Section
3 103(a) only denies patentability to those inventions whose "subject matter as a whole would have been
4 obvious at the time the invention was made to a person having ordinary skill in the art to which said
5 subject matter pertains." (35 U.S.C. § 103.) The teachings from the prior art utilized to determine
6 obviousness must be reasonably pertinent to the problems solved by Applicant's invention. (See In re
7 Clay, 23 USPQ2d 1058, 1060 (CAFC 1992).) If the subject matter and purpose of Applicant's
8 invention are different from the subject and purpose of the invention described in a prior art
9 reference, it would be improper to utilize that reference in the obviousness analysis as a person skilled
10 in the art would not have been motivated to look to or consider such a reference in attempting to solve
11 the problems solved by Applicant's invention. (See In re Clay, 23 USPQ2d at 1061.) Under such
12 circumstances, a person having ordinary skill in the art would not apply the teachings of the prior art
13 to arrive at Applicant's invention. (Id.)

14 Even if certain prior art references are considered analogous art, there must be
15 something in these references that suggests combining their teachings in order to reject claims under
16 the obviousness standard. As stated by the court in In re Geiger, 2 USPQ2d 1276 (CAFC 1987),
17 "[o]bviousness cannot be established by combining the teachings of the prior art to produce the
18 claimed invention, absent some teaching, suggestion or incentive supporting the combination." (In re
19 Geiger, 2 USPQ2d at 1278.) The motivation or suggestion to combine references must exist,
20 otherwise the determination of obviousness involves nothing more "than indiscriminately combining
21 prior art." (Micro Chemical Inc. v. Great Plains Chemical Co., 41 USPQ2d 1238, 1244 (CAFC
22 1997).) In In re Fritch, 23 USPQ2d 1780 (CAFC 1992), the Federal Circuit stated the following:

23 In proceedings before the Patent and Trademark Office, the Examiner bears the burden of
24 establishing a prima facie case of obviousness based upon the prior art. The Examiner can
25 satisfy this burden only by showing some objective teaching in the prior art or that knowledge
26 generally available to one of ordinary skill in the art would lead that individual to combine the
27 relevant teachings of the references.

1 Obviousness cannot be established by combining the teachings of the prior art to produce the
2 claimed invention, absent some teaching or suggestion supporting the combination. Under
3 section 103, teachings of references can be combined *only* if there is some suggestion or
4 incentive to do so. Although couched in terms of combining teachings found in the prior art,
5 the same inquiry must be carried out in the context of a purported obvious "modification" of
6 the prior art. The mere fact that the prior art may be modified in the manner suggested by the
7 Examiner does not make the modification obvious unless the prior art suggested the
8 desirability of the modification.

9
10 Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is
11 impermissible to use the claimed invention as an instruction manual or "template" to piece
12 together the teachings of the prior art so that the claimed invention is rendered obvious. This
13 court has previously stated that one cannot use hindsight reconstruction to pick and choose
14 among isolated disclosures in the prior art to deprecate the claimed invention. (In re Fritch,
15 23 USPQ2d at 1783-84 (internal quotes and citations removed).)

16
17 The above principles are applied to the Examiner's rejections of the various claims set
18 forth in the Office Action. As set forth below, it is Applicant's position that the currently pending
19 claims are not obvious in light of the prior art.

20
21 Claims 1, 2, 6, 8, 9, 12 and 17

22
23 The Examiner rejected claims 1, 2, 6, 8, 9, 12 and 17 under 35 U.S.C. § 103(a) as
24 being unpatentable over Lemelson (U.S. Patent No. 3,933,311) in view of Gruber (DE 3,039971 A).
25 With regard to claim 1, the Examiner takes the position that Lemelson discloses a landscape edging
26 system having a core with two longitudinal channels disposed therein and a connector having a sleeve
27 portion with an internal body member having several extending portions thereon that are each
28 configured to be received in one of the channels and that Gruber discloses a landscape edging with a
29 core having a relatively thin shell layer. Based on the above, the Examiner takes the position that it
30 would have been obvious to modify the edging system of Lemelson by adding a plastic coating as
31 disclosed by Gruber so as to provide a protective covering. The Examiner also references Beladakis
32 (U.S. Patent No. 5,715,628) with regard the teaching utilizing a protective coating for lawn edgings.
33 Respectfully, Applicant disagrees with the Examiner's analysis with regard to the obviousness of
34 combining Lemelson with Gruber and/or Beladakis..

1 With regard to the modification of Lemelson edging system by adding the plastic
2 coating of Gruber, Applicant respectfully believes the Examiner is mistaken and that it would not
3 have been obvious at the time of Applicant's invention to add the coating of Gruber to the edging
4 system of Lemelson to obtain Applicant's invention. The abstract of Gruber discusses a panel used
5 for forming a landscape boundary that can be made of "rigid or elastic plastics, or metal, which may
6 have a plastic coating." Applicant believes that the proper interpretation of the Gruber patent is that
7 because the panel is configured to be placed in the ground where corrosion of metals will be a
8 problem, the panel can be made of plastic, which is substantially corrosion resistant, or made out of
9 metal with the metal having a plastic coating to prevent corrosion of the metal. For this purpose,
10 there would be no need to coat the plastic with another plastic. Further, the landscape "fence
11 structure" of Lemelson is not adaptable for coating with another material and no mention or
12 suggestion is present in Lemelson to coat the fence structure with another material. Lemelson is
13 directed to an assembly of a plurality of lattice-like units 11 having a central portion 12 with a sheet-
14 like wall 13 having openings 14 therein. To coat the fence structure would be to loose the lattice-like
15 effect of the Lemelson invention. No reference, discussion or even suggestion is made to place a
16 relatively thin shell layer around the lattice-like units and it could not be done without substantial
17 difficulty in maintaining the openings 14 in wall 13. The brief mention of making the central portion
18 out of metal is made without any reference to needing to coat the metal to prevent corrosion, leading
19 to the conclusion that only a corrosion resistant metal would be suitable for the fence structure of
20 Lemelson. To suggest otherwise appears to require an application of hindsight to obtain a coated,
21 lattice-like structure that provides the benefits set forth in Lemelson with the coating of Gruber, which
22 is improper for the obviousness analysis. (See In re Fritch, 23 USPQ2d at 1783-84.)

23 The patent to Beladakis discloses a landscape divider cap that is utilized as a protective
24 or ornamental covering for landscape dividers that is configured to be placed over the exposed
25 exterior of an upper section of the landscape divider. The cap is made of flexible plastic that
26 effectively "snaps" over the divider to change the appearance of the landscape divider or repair a

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1 damaged section of the landscaped divider. As discussed above with Gruber, this type of covering is
2 incompatible with the lattice-like structure of Lemelson.

3 With regard to the edging strip of the present patent application, the teachings of both
4 Gruber and Beladakis are not reasonably pertinent to the problems solved by Applicant's invention.
5 (See In re Clay, 23 USPQ2d at 1060.) Because the subject matter and purpose of Applicant's
6 invention are substantially different from the subject and purpose of the inventions described in
7 Gruber and Beladakis, it is improper to utilize these patents in the obviousness analysis because a
8 person skilled in the art would not have been motivated to look to or consider them in attempting to
9 solve the problems solved by Applicant's invention. (See Id. at 1061.) Even if these patents are
10 considered pertinent to Applicant's invention, neither Lemelson, Gruber nor Beladakis are concerned
11 with, discuss or are in any way related to providing an edging strip having an inner core layer
12 substantially encapsulated by a thin shell layer. As such, nothing suggests or compels combining the
13 teachings of Lemelson with Gruber or Beladakis, in any combination suggested by the Examiner, to
14 arrive at Applicants' invention. As stated by the court in In re Geiger, "[o]bviousness cannot be
15 established by combining the teachings of the prior art to produce the claimed invention, absent some
16 teaching, suggestion or incentive supporting the combination." (In re Geiger, 2 USPQ2d at 1278.)
17 The motivation or suggestion to combine the references must exist, otherwise the determination of
18 obviousness involves nothing more "than indiscriminately combining prior art." (Micro Chemical, 41
19 USPQ2d at 1244; In re Fritch, 23 USPQ2d at 1783-84.) Respectfully, nothing in the Lemelson,
20 Gruber or Beladakis references or any knowledge generally available to one of ordinary skill in the art
21 compels, teaches, suggests or even offers any incentive such that an individual wanting to invent a
22 dual layer edging strip with internal channels disposed in the inner layer such as Applicant's would
23 utilize the references as suggested by the Examiner. (See In re Fritch, 23 USPQ2d at 1783; In re
24 Geiger, 2 USPQ2d at 1278.

25 With regard to the connector portion of Applicant's landscape edging system, Applicant
26 disagrees with the Examiner that Lemelson discloses a connector having a sleeve portion with an
27

1 internal body member having several extending portions thereon that are configured to be received in
2 the channels of the edging strip. Specifically, the sleeve portion, allegedly shown as 25, 26, 22, 27
3 and 28 of Fig. 1, is not a sleeve as that term is used in Applicant's invention and neither the internal
4 body member (22) nor the extending portions (26A, 26B, 28A and 28B of Figs 1 and 2) are internal
5 to the sleeve portion. Instead, as clearly shown in the figures, item 22 is a central shank or tubular
6 formation that is not internal to the "sleeve" and the extending portions are also not internal to the
7 identified "sleeve" portion. In fact, neither the central shank nor the extending portions are internal
8 to any part of the connector or coupling member in Lemelson. Figure 2 is an end view of the lattice-
9 like units or, in Applicant's terms, the edging strip portion of the system. With regard to Applicant's
10 invention, the sleeve portion, which is described beginning at page 19, line 14 and best shown in
11 Figure 3, is a generally channel-shaped member having open ends 44 and 46 configured to receive an
12 end of the edging strip therein such that the sleeve portion covers the ends of two adjoining edging
13 strips. To further clarify the configuration of the connector of Applicant's invention, Applicant is
14 amending claim 1 to specifically identify the sleeve portion as being channel-shaped and having open
15 first and second ends that are configured to receive an end of the edging strip therein and to
16 specifically identify the internal body member as being disposed in the sleeve portion. This
17 configuration is disclosed in the above-identified text and Figure 3 of Applicant's description.
18 Applicant believes the amended language sufficiently clarifies his invention, as set forth in claim 1,
19 and distinguishes from the prior art referenced by the Examiner.

20 With regard to the dependent claims which depend from claim 1, these claims are
21 believed to be allowable based on the believed allowability of claim 1. In addition, Applicant
22 disagrees with the Examiner's analysis with regard to claim 2. Specifically, Applicant disagrees that
23 it would have been obvious to further modify the invention of Lemelson, as modified by Gruber, by
24 utilizing the co-extrusion mentioned in Lemelson. In addition to the relationship between Lemelson
25 and Gruber discussed above, Lemelson's use of the term co-extrusion is entirely different than that
26 term is utilized in Applicant's invention. Lemelson discusses forming the tubular formations 15 and

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1 17 at the same time as the central portion 12 to form a unitary extrusion. As clearly set forth in
2 Applicant's disclosure, the preferred method of making the edging strip having a shell layer
3 encapsulating the core layer is to co-extrude the core layer and the shell layer such that they form a
4 substantially unitary component. As discussed above, there is no reason or reasonable ability to co-
5 extrude Lemelson with the "covering" referenced in Gruber. The "co-extruding" mentioned in
6 Lemelson is of a different type and for a different purpose than that utilized by Applicant in the
7 present invention. Nevertheless, Applicant is amending claim 2 to further clarify that the core layer
8 and shell layer are co-extruded in a manner such that the shell layer substantially encapsulates the core
9 layer. Support for this amendment is found at page 13, lines 8 through 12 of Applicant's description
10 and shown in Figure 2.

11 With regard to independent claim 12, Applicant is amending claim 12 as identified
12 above for claims 1 and 2. Applicant's arguments with regard to the obviousness of claims 1 and 2 in
13 light of Lemelson and Gruber (or Beladakis) are also applicable to claim 12 and, therefore, are
14 incorporated herein with respect to claim 12. With regard to the dependent claims which depend
15 from claim 12, these claims are believed to be allowable based on the believed allowability of claim
16 12 in light of the arguments and amendments set forth herein.
17

18 Claims 3-5 and 13-15

19 The Examiner rejects claims 3-5 and 13-15 as being unpatentable over Lemelson in
20 view of Gruber in further view of Walsh et al., in that Walsh describes the use of re-grind plastic as a
21 core material, the use of high quality plastic as a shell and the combination of the two for a plastic
22 component such as Applicant's edging strip. Initially, Applicant's arguments with regard to the
23 obviousness of claims 1 and 12 in light of Lemelson and Gruber (or Beladakis) are also applicable to
24 claims 3-5 and 13-15 and, therefore, are incorporated herein with respect to claims 3-5 and 13-15. In
25 addition, because claims 3-5 depend from amended claim 1 and claims 13-15 depend from amended
26 claim 12, these claims are believed to be allowable based on the believed allowability of claims 1 and

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1 12, respectively, in light of the arguments and amendments set forth above. In addition, with regard
2 to the use of re-grind or recycled materials for the core layer, high quality plastic for an thin shell
3 layer and the combination of the two for an edging strip, such use is not referenced, discussed or
4 suggested by anything in either Lemelson or Gruber and, as such, it would not be obvious to one
5 skilled in the art to apply the teachings of Walsh to Lemelson and Gruber to obtain Applicant's
6 invention. (See *In re Geiger*, 2 USPQ2d at 1278.) In addition, Walsh is not directly related to
7 landscape edging systems and, to Applicant's knowledge, use of co-extrusion to substantially
8 encapsulate a core layer made out of re-grind or recycled materials with a higher quality outer shell
9 layer has never been utilized for a landscape edging strip or divider.

10

11 Claims 7 and 16

12 The Examiner rejected claims 7 and 16 as being unpatentable over Lemelson in view of
13 Gruber in further view of Wuster in that the limitations of claims 1 and 12, the base independent
14 claims, are obvious as set forth above and that Wuster discloses a connector having extending
15 portions that are tapered. Applicant's arguments with regard to the obviousness of claims 1 and 12 in
16 light of Lemelson and Gruber (or Beladakis) are also applicable to claims 7 and 16 and, therefore, are
17 incorporated herein with respect to claims 7 and 16. In addition, because claim 7 depends from
18 amended claim 1 and claim 16 depends from amended claim 12, these claims are believed to be
19 allowable based on the believed allowability of claims 1 and 12, respectively, in light of the
20 arguments and amendments set forth above.

21

22 Claims 10, 11 and 18

23 The Examiner rejected claims 10, 11 and 18 as being unpatentable over Lemelson in
24 view of Gruber in further view of Danna, et al. in that the limitations of claims 1 and 12, the base
25 independent claims, are obvious as set forth above and that Danna discloses a stake member
26 configured to engage the edging strip to the ground. Applicant's arguments with regard to the

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1 obviousness of claims 1 and 12 in light of Lemelson and Gruber (or Beladakis) are also applicable to
2 claims 7 and 16 and, therefore, are incorporated herein with respect to claims 7 and 16. In addition,
3 because claim 7 depends from amended claim 1 and claim 16 depends from amended claim 12, these
4 claims are believed to be allowable based on the believed allowability of claims 1 and 12,
5 respectively, in light of the arguments and amendments set forth above. With regard to claim 11,
6 Applicant disagrees with the Examiner with regard to Figure 6 of Danna showing a stake penetrating
7 the side of an edging strip. Danna shows the stake through the top of the edging strip, not the side of
8 the edging strip as shown in Figure 4 and discussed at page 23, lines 6-13 of Applicant's disclosure
9

10 Claims 21 and 22

11 New claim 21 is an independent claim and new claim 22 depends therefrom. Claim 21
12 is similar to claim 12 with the additional limitations of the shell layer being integrally formed around
13 the core layer and the extending portions of the internal body member being configured to be securely
14 received in the channels of the edging strip. Applicant's arguments with regard to the obviousness of
15 claims 1 and 12 in light of Lemelson and Gruber (or Beladakis) are also applicable to claim 21 and,
16 therefore, are incorporated herein with respect to claim 21. Claim 22 adds the limitations of claim 5
17 not already in claim 21. Applicant's arguments with regard to claim 5 above are also applicable to
18 claim 22. In addition, claim 22 depends from claim 21 and, therefore, is believed to be allowable as
19 being dependent from an allowable base claim.

20 In light of the arguments and amendments set forth above, Applicant respectfully
21 requests the Examiner to withdraw the rejection of claims 1-18 set forth in the office action and to
22 allow new claims 21 and 22. The original application included three independent claims and twenty
23 total claims. Two claims are being cancelled by this amendment, one being an independent claim and
24 one a dependent claim. One new independent claim and one dependent claim are being added by this
25 amendment. Therefore, no additional fees for claims are believed due.
26

1 In view of the foregoing, it is submitted that this application is in condition for
2 allowance. Reconsideration of the rejections and objections in light of this Amendment is requested.
3 Allowance of Claims 1-18 and 21-22 is respectfully solicited.

4

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6 Respectfully Submitted,

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